



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,233	06/26/2003	Eric E. Blohm	077047-9497-00	5865
23409 7590 12/03/2008 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
BATTULA, PRADEEP CHOUDARY				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
12/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,233

Applicant(s)

BLOHM ET AL.

Examiner

PRADEEP C. BATTULA

Art Unit

3725

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution After Appeal Brief or Reply Brief

In view of the appeal brief filed on October 14, 2008, PROSECUTION IS
HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or, (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claim 20, neither the specifications nor the drawings contain any indication on how the alternate piece will be generated on the binding line and sent to the recipient in electronic format.

This rejection has previously been brought up to Applicant cited section 2163 and the written description requirement. However, the written description only presents doing an offline electronic format and the written description provides no indication how other electronic formats will be provided on the binding line. For example, are the CDs attached to signatures that are placed in hoppers? Applicant stated that a general allegation is not a sufficient reason to support a rejection for lack of adequate written

description; however, a mere statement in the specification is not a proper written description. Neither is a statement stating that such is well known in the art and one with skill in the art would not ask such a question. Applicant must provide evidence that such is well known in the art.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 and 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 and 26 recites the limitation "the portion" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 4, 6, 9, 10, 11, 13, and 21 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Graushar (U.S. 6,347,260).

In regards to Claim 1, Graushar discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; and putting an alternate piece of an alternate medium compared to

the pre-personalized book in place of each rejected pre-personalized book to be delivered to the specific individual (Column 3, Lines 1 – 4; Column 2, Lines 1 – 15, 50 – 67, and Column 3, Lines 1 – 4; the passages teach of a generic book [individualized medium to non individualized medium] and since it does not have the same information as a pre-personalized book it is of a different medium. Furthermore this interpretation is derived from applicant's specification where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted).

In regards to Claim 3, as applied to Claim 1, Graushar further discloses wherein the pre-personalized book includes a pre-personalized signature (Column 2, Lines 50 – 55 teaches feeders 12 hold the signatures for the pre-personalized book).

In regards to Claim 4, as applied to Claim 1, Graushar further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 3, Lines 1 – 4; does not say one way or the other how the alternate piece is produced but considering how it is entered into the binding line it is inherent it is generated off the binding line).

In regards to Claim 6, as applied to Claim 1, Graushar further discloses the alternate piece is a printed product (Column 3, Lines 1 – 4).

In regards to Claim 9, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15, 23 – 25, 50 – 52; the books being produced in zip code order show that there is a mailing list); generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; identifying the recipient of the rejected pre-personalized book (Column 3, Line 1 – 4; it is inherent the person is identified since the individual will receive a generic book and therefore the person is identified at some point.) and putting an alternate piece that replaces the rejected pre-personalized book and notifies the recipient of the status (Column 3, Lines 1 – 4; Applicant has discussed the subscriber does not know they are receiving the book, however, this is not even mentioned in the claim. Therefore, as broadly claimed, it is considered the recipient can be aware of what they are going to receive).

In regards to Claim 10, as applied to Claim 9, Graushar further discloses the alternate piece is a printed product (Column 3, Lines 1 – 4).

In regards to Claim 11, as applied to Claim 9, Graushar further discloses wherein the book includes pre-personalized information (Column 3, Lines 5 - 11) and the alternate piece includes the pre-personalized information (Even though the book is generic and is put on the binding line after the printers it is inherent that there is a portion of pre-personalized information since the book is still coming to the customer at a particular address and therefore pre-personalized information is provided with the book).

In regards to Claim 13, as applied to Claim 1, Graushar further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 3, Lines 1 – 4; does not say one way or the other how the alternate piece is produced but considering how it is entered into the binding line it is inherent it is done off the binding line).

In regards to Claim 21, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15, 23 – 25, 50 – 52; the books being produced in zip code order show that there is a mailing list); generating a pre-personalized printed product off-line for selected recipients on the mailing list (Column 2, Lines 50 – 55; the feeders 12 hold the signatures for the pre-personalized book so the signatures would be the printed product since they are created before they are in the feeders); the ability to load the pre-personalized printed products adjacent the binding line (Column 2, Lines 50 – 55; Figure 1, Items 12, 14; Applicant has failed to define a frame of reference to define the adjacent nature. The feeders, where the signatures are loaded, are on the binding line as well as the trimming stations 24. The feeders are adjacent the trimmers which are on the binding line and therefore the feeders are adjacent the binding line); assembling a book for each recipient including a respective pre-personalized printed product (Column 2, Lines 50 – 55); rejecting selective recipients' books (Column 2, Lines 66 – 67 --> Column 3, Lines 1 - 4); and generating an alternate piece in place of each rejected book (Column 3, Lines 1 - 4) the alternate piece being of a different medium than the pre-personalized printed product (Column 2, Lines 1 – 15, 50 – 67, and Column 3, Lines 1 – 4; the passages teach of a

generic book and since it does not have the same information as a pre-personalized book it is of a different medium [personalized medium replaced by a non-personalized medium]. Furthermore this interpretation is derived from applicant's spec where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted).

In regards to Claim 22, as applied to 21, Graushar further discloses wherein the alternate piece includes at least a portion of the pre-personalized information contained in the pre-personalized printed product for a given selected recipient (Even though the book is generic and is put on the binding line after the printers it is inherent that there is a portion of pre-personalized information since the book is still coming to the customer at a particular address and therefore pre-personalized information is provided with the book).

In regards to Claim 23, as applied to Claim 21, Graushar further discloses the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 3, Lines 1-4).

2. Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gruber et al. (Gruber; U.S. 4,395,031)

In regards to Claim 24, Gruber discloses a binding method comprising: generating a pre-personalized book on a binding line (Column 5, Lines 8 – 26; teaches that signatures are dropped by the feeders on a conveyor and that a printer prints on pages with customized information) for a plurality of specific individuals (Column 5, Lines 22 – 26 teaches of mailing label; Column 3, Lines 27 – 35 teaches of subscriber information and on a binding line subscriber information can only be printed and information can only be pre-personalized with a mailing list; Column 11, Lines 13 – 14 teaches of mailing distributions), each pre-personalized book having therein a pre-personalized signature 31 (Column 5, Lines 22 – 26; Figure 12, Item 31); rejecting selective pre-personalized books (Column 5, Lines 27 – 33); reprinting the pre-personalized signature of one of the rejected pre-personalized books (Column 3, Lines 55 – 60; Claim 22); and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (Column 5, Lines 8 – 26 teaches of the creation and printing on the binding line; Column 3, Lines 55 – 60 and Claim 22 teaches of reprinting).

In regards to Claim 25, Gruber further discloses wherein the step of reprinting the pre-personalized signature is done on the binding line (Column 5, Lines 8 – 26 teaches of the creation and printing on the binding line; Column 3, Lines 55 – 60 and Claim 22 teaches of reprinting).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 25 and 28 – 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Graushar et al. (Graushar '219; U.S. 6,694,219)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In regards to Claim 1, Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line 10 for a specific individual (Column 4, Lines 9 – 23, 58 – 62; Column 5, Lines 12 – 14; Figure 1, item 10; Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); rejecting selective pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); and generating an alternate piece (Column 5, Lines 27 – 32), of an alternate medium compared to the pre- personalized book (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical),

in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 12 – 14 teaches of assembly of books by zip codes so a reproduced book after a rejection will still go to the same zip code and maintain that order).

In regards to Claim 2, Graushar '219 further discloses wherein the pre-personalized book includes pre- personalized information and the alternate piece includes the same pre-personalized information (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical).

In regards to Claim 3, Graushar '219 further discloses wherein the pre-personalized book includes a pre- personalized signature (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical).

In regards to Claim 4, Graushar '219 further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 4, Lines 9 – 18; teaches that the hoppers hold signatures and only customized signatures are printed online and Column 5, Lines 27 – 32 teach of standard signatures. Therefore any of the standard sheets in the alternate piece are generated offline).

In regards to Claim 5, wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 4, Lines 9 – 18; teaches that the hoppers hold signatures and only customized/personalized signatures are printed online and Column 5, Lines 27 – 32 teaches of replacements and they can have customized

signatures. Therefore any of the standard sheets in the alternate piece are generated offline).

In regards to Claim 6, Graushar '219 further discloses wherein the alternate piece is a printed product (Column 5, Lines 27 – 32).

In regards to Claim 7, Graushar '219 further discloses wherein the alternate piece is a postcard (It is very well known in the art that mailed items such as books, magazines, and catalogs contain subscription and renewal cards which are postcards).

In regards to Claim 8, Graushar '219 further discloses wherein the alternate piece is in electronic format (Column 5, Lines 23 - 32; The Examiner considers the alternate piece to be both the CD and printed media).

In regards to Claim 9, Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Column 5, Lines 12 – 14; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 4, Lines 59 – 63 teaches of the personalized CDs; Column 5, Lines 23 – 32 teaches of reading the information on the personalized CDs from rejected magazines); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 23 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column

5, Lines 27 – 32 teaches of the customized information in the replacement which can easily be notification information).

In regards to Claim 10, Graushar '219 further discloses wherein the alternate piece is a printed product (Column 5, Lines 27 – 32).

In regards to Claim 11, Graushar '219 further discloses wherein the pre-personalized book includes pre- personalized information and the alternate piece includes the pre-personalized information (Column 4, Lines 9 – 18 teaches of customizing the sheets of the original publication on the binding line; Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical).

In regards to Claim 12, Graushar '219 further discloses wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 4, Lines 9 – 18 teaches of printing customized signatures online; Column 5, Lines 27 – 32 teaches of replacing the rejected piece by remaking the publication).

In regards to Claim 13, Graushar '219 further discloses wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line (Column 4, Lines 9 – 18; teaches that the hoppers hold signatures and only customized signatures are printed online and Column 5, Lines 27 – 32 teach of standard signatures. Therefore any of the standard sheets in the alternate piece are generated offline).

In regards to Claim 14, Graushar '219 further discloses wherein the alternate piece is in electronic format (Column 5, Lines 23 - 32; The Examiner considers the alternate piece to be both the CD and printed media).

In regards to Claim 15, Graushar '219 discloses a method of replacing a rejected book (Column 1, Lines 19 - 25) on a binding line, the method comprising: generating a mailing list of recipients having a mailing order (Column 5, Lines 12 - 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); assembling a pre-personalized book on the binding line 10 for each recipient according to the mailing list (Column 4, Lines 9 - 23, 58 - 62; Column 5, Lines 12 - 14; Figure 1, item 10); rejecting selective pre-personalized books (Column 4, Lines 64 -67 → Column 5, Lines 1 - 2, 23 - 25); generating an alternate piece on the binding line (Column 5, Lines 27 - 32), the alternate piece being of a format different from the rejected pre-personalized book (Column 5, Lines 27 - 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical); and replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order (Column 5, Lines 12 - 14 teaches of assembly of books by zip codes so a reproduced book after a rejection will still go to the same zip code and maintain that order).

In regards to Claim 16, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is a postcard (It is very well known in the art that mailed

items such as books, magazines, and catalogs contain subscription and renewal cards which are postcards).

In regards to Claim 17, as applied to Claim 15, Graushar '219 further discloses wherein the pre-personalized book includes pre- personalized information (Column 4, Lines 58 – 62; Graushar '219) and the alternate piece includes the same pre-personalized information of the pre-personalized book (Column 5, Lines 30 – 32; the replacement product can be personalized/customizable and therefore allowing for any type of indicia and information; Graushar '219).

In regards to Claim 18 as applied to Claim 15, Graushar '219 modified by _ further discloses wherein the pre-personalized book includes pre- personalized information (Column 4, Lines 58 – 62; Graushar' 219) and the alternate piece includes different pre-personalized information of the pre-personalized book (Column 5, Lines 30 – 32; the product can be personalized/customizable and therefore allowing for any type of indicia and information; Graushar '219. The Examiner further considers, throughout the action, that the replacements are to be considered in its entirety).

In regards to Claim 19, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is a printed product (Column 5, Lines 27 – 32; Graushar '219).

In regards to Claim 20, as applied to Claim 15, Graushar '219 further discloses wherein the alternate piece is in electronic format (Column 5, Lines 23 - 32; The Examiner considers the alternate piece to be both the CD and printed media; Graushar '219).

In regards to Claim 21, Graushar '219 discloses binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized printed product off-line for selected recipients on the mailing list (Column 4, Lines 9 – 23; teaches that the hoppers hold signatures and only customized/personalized signatures are printed online. Therefore any of the standard sheets in the piece are generated offline and therefore the printed product is generated offline since some of the sheets are produced offline); loading the pre-personalized printed products adjacent a binding line (Column 4, Lines 9 – 18 teaches of Hoppers 14 – 17; Figures 1 & 4, Items 14 – 17 are adjacent the binding line); assembling a book for each recipient including a respective pre-personalized printed product (Column 4, Lines 9 – 18 teach of the personalized/customized signatures); rejecting selective recipients' books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); removing the rejected books from the binding line (Column 5, Lines 24 – 28, 32 – 34); and generating an alternate piece in place of each rejected book (Column 5, Lines 27 – 35 teaches of almost immediate reordering of the rejected book and therefore maintains the zip code ordered and even the same spot in the bundle), the alternate piece being of a different medium than the pre-personalized printed product (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical where personalized information is always possible).

In regards to Claim 22, Graushar '219 further discloses wherein the alternate piece includes at least a portion of the pre-personalized information contained in the pre-personalized printed product for a given selected recipient (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical where personalized information is always possible).

In regards to Claim 23, Graushar '219 further discloses the method further including the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 5, Lines 27 – 32; the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical).

In regards to Claim 24, Graushar '219 a binding method comprising: generating a pre-personalized book on a binding line for a plurality of specific individuals (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated; Column 4, Lines 9 – 23, 58 – 62; Column 5, Lines 12 – 14; Figure 1, item 10; teaches of making the printed product), each pre-personalized book having therein a pre-personalized signature (Column 4, Lines 9 – 18); rejecting selective pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); reprinting the pre-personalized signature of one of the rejected pre-personalized books (Column 4, Lines 9 – 18 teaches of printing customized signatures online; Column 5, Lines 23 – 32 teaches of

replacing the rejected piece by remaking the publication); and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (Column 4, Lines 9 – 18 teaches of printing customized signatures online; Column 5, Lines 27 – 32 teaches of replacing the rejected piece by remaking the publication).

In regards to Claim 25, Graushar '219 further discloses wherein the step of reprinting the portion is done on the binding line (Column 4, Lines 9 – 18 teaches of printing customized signatures online; Column 5, Lines 27 – 32 teaches of replacing the rejected piece by remaking the publication).

In regards to Claim 28, Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized printed product for each recipient and assembling a book on a binding line 10 for each recipient (Column 4, Lines 9 – 23, 58 – 62; Column 5, Lines 12 – 14; Figure 1, item 10), each said book including the respective pre-personalized piece (Column 4, Lines 9 – 18); rejecting selective books Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); removing the rejected books from respective spaces along the binding line (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 28, 32 – 34); generating an alternate pre-personalized piece for each recipient whose book was rejected (Column 5, Lines 27 – 32), the alternate pre-personalized piece being of a different medium than the pre-personalized printed product Column 5, Lines 27 – 32; the alternate piece can be

standard, customized, personalized, or customized/personalized and therefore can have a format that is different or identical. Furthermore different information is a different medium); and inserting the alternate pre-personalized piece (the entire publication) into the space previously occupied by the respective rejected book (Column 5, Lines 27 – 35 teaches of immediate reordering of the rejected book and therefore maintains the zip code ordered and even the same spot in the bundle).

In regards to Claim 29, Graushar '219 further discloses wherein generating the alternate pre- personalized piece is done on the binding line (Column 4, Lines 9 – 18 teaches of printing customized signatures online; Column 5, Lines 27 – 32 teaches of replacing the rejected piece by remaking the publication).

In regards to Claim 30, Graushar '219 further discloses wherein generating the alternate pre-personalized piece is done off line with respect to the binding line (Column 4, Lines 9 – 18; teaches that the hoppers hold signatures and only customized signatures are printed online and Column 5, Lines 27 – 32 teach of standard signatures. Therefore any of the standard sheets in the alternate piece are generated offline).

In regards to Claim 31, Graushar '219 discloses method of replacing a rejected book on a binding line, the method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); assembling a pre-personalized book on the binding line 10 for each recipient (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting selected pre-personalized books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 2); replacing a first

rejected book with a generic book (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized); replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore the information can be identical); and replacing a third rejected book with a different medium (Column 5, Lines 28 – 33; teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore the information can be identical. The interpretation of the different medium is derived from applicant's specification where applicant states "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification it has been broadly interpreted).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 5, 7, 8, 12, 14, and 29 are a rejected under 35 U.S.C. 103(a) as being obvious over Graushar (U.S. 6,347,260) in view of Graushar et al. (Graushar '219; U.S. 6,694,219).

Graushar '219 has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

In regards to Claim 2, as applied to Claim 1, Graushar does not disclose wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 - 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized

books (Column 4, Lines 64 – 67 → Column 5, Lines 1 - 5, 23 - 27); and generating an alternate piece, of an alternate medium compared to the pre- personalized book (Column 5, Lines 27 – 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 – 32; a replacement magazine is made that can be standard, personalized, customized, or personalized/customized and can therefore have the same or different information). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 5, Graushar does not disclose wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 - 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized books (Column 4, Lines 64 - 67 → Column 5, Lines 1 - 5, 23 - 27); and generating an alternate piece, of an alternate medium compared to the pre-personalized book (Column 5, Lines 27 - 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a medium is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 - 32; a replacement magazine is made that can be personalized) and wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 5, Lines 5 - 8 teaches of printing the address on the book; Column 5, Lines 25 - 30; system fabricates the replacement and therefore is on the binding line and since

the entire book is fabricated again from the starting point it is inherent it goes through the quality check again and would therefore go to the printing stations following the quality check). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 7, as applied to Claim 6, Graushar further discloses the alternate piece is a postcard (Column 1, Lines 9 – 13 teaches of mixing third class publications with second class publications; Column 1, Lines 24 – 31 teaches that second class publications are usually including editorial content and third class includes advertising material; Column 2, Lines 62 – 65 teaches that the generated book can have a postcard)

Graushar does not disclose the alternate piece is a postcard.

Graushar '219 discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 3, Lines 64 - 65; Column 5, Lines 13 – 17; passages disclose a book can be made with this production method and the examiner considers the pre-personalized since the magazine is printed with address indicia when on the binding line); rejecting selective pre-personalized

books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 5, 23 – 27); and generating an alternate piece, of an alternate medium compared to the pre- personalized book (Column 5, Lines 27 – 32; a customized/personalized replacement book can have different, less or more information and an item of different, less, more information is not the same medium since it has different information. This definition is also derived from applicant's spec wherein "The alternate piece may be in the form of a postcard, a book, a special interest publication or other printed media or in the form of electronic media such as a CD, e-mail message, magnetic tape, or the like" and Applicant has not defined what a "different medium" is to be considered as this is not defined at any point in the Specification and therefore has been broadly interpreted), in place of each rejected pre-personalized book to be delivered to the specific individual (Column 5, Lines 23 – 32; a replacement magazine is made that can be standard, personalized, customized, or personalized/customized and can therefore have the same or different information). It is also well known in the art of publications that postcards such as renewal cards or subscription cards are included with mailed publications. It is inherent that the book of Graushar '219 would have such a postcard. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the

personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 8, as applied to Claim 1, Graushar does not disclose the alternate piece is in electronic format.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book with an electronic format and book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column 5, Lines 27 – 32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the alternate piece is in electronic format (Column 5, Lines 23 – 32 – Graushar '219; The Examiner considers the alternate piece to be both the CD and printed media. Even though the CD is same, the entirety of the product is not the same as the original and therefore a different medium). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic

information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 12, Graushar does not disclose wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (Column 5, Lines 27 – 32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 5, Lines 5 – 8 teaches of printing the address on the book which is on the binding line – Figure 1, Item 35; Column 5, Lines 25 – 30; system fabricates the replacement and therefore is on the binding line

and since the entire book is fabricated again from the starting point it is inherent it goes through the quality check again and would therefore go to the printing stations following the quality check). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 14, as applied to Claim 9, Graushar does not disclose the alternate piece is in electronic format.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized book with an electronic format and book for each recipient on a binding line 10 (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10); rejecting one of the pre-personalized books (Column 4, Lines 64 – 67 → Column 5, Lines 1 – 2, 23 – 25); identifying the recipient of the rejected pre-personalized book (Column 5, Lines 27 – 30, 34 – 37); and generating an alternate piece that replaces the rejected pre-personalized book (Column 5, Lines 27 – 32), wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized

book (Column 5, Lines 27 – 32; the customizing/personalizing capability of the media fabrication allows for such a notification of status) and wherein the alternate piece is in electronic format (Column 5, Lines 23 – 32 – Graushar '219; The Examiner considers the alternate piece to be both the CD and printed media. Even though the CD is different the entirety of the product is not the same as the original and therefore a different medium). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 – 62; Column 4, Lines 58 – 62; Graushar '219).

In regards to Claim 29, Graushar does not disclose wherein generating the alternate pre-personalized piece is done on the binding line.

Graushar '219 discloses a binding method comprising: generating a mailing list of recipients (Column 5, Lines 12 – 14 teaches of assembly by zip code and therefore there is a master mailing list which is divided into zip codes and therefore a mailing list was generated); generating a pre-personalized printed product for each recipient; assembling a book on a binding line for each recipient (Column 4, Lines 9 – 23, 58 – 62; Figure 1, item 10), each said book including the respective pre-personalized piece (Column 4, Lines 58 - 62); rejecting selective books (Column 4, Lines 64 - 67 → Column

5, Lines 1 - 2); removing the rejected books from respective spaces along the binding line (Column 5, Lines 24 - 28); generating an alternate pre-personalized piece for each recipient whose book was rejected on the binding line (Column 5, Lines 28 - 33; the book is fabricated again and it was done on the binding line the first time), the alternate pre-personalized piece being of a different medium than the pre-personalized printed product (Column 5, Lines 28 - 33 teaches the alternate piece can be standard, customized, personalized, or customized/personalized and therefore can have a format that is different with different information and therefore being a different medium); and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (Column 5, Lines 12 - 14; the books are produced in zip code order and therefore the reordered magazines assume a place of the rejected magazine in the zip code bundle). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Graushar with the method of Graushar '219 of producing and reproducing customized/personalized books having electronic information with the feeders of personalized signatures and printers disclosed in Graushar '219 in order to allow the recipient of the book to receive a customized book accompanied with personalized electronic information and enhance the mount and quality of the personalized printed product (Column 1, Lines 57 - 62; Column 4, Lines 58 - 62; Graushar '219).

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being obvious over Gruber in view of Anderson et al. (Anderson; U.S. 3,819,173)

In regards to Claim 26, Anderson teaches a binding method (Column 1, Lines 36 – 47) comprising: generating a pre-personalized book on a binding line for a plurality of specific individuals (Column 1, Lines 24 – 47; particular signatures for a particular subscriber is personalizing), each pre-personalized book having therein a pre-personalized signature (Column 1, Lines 50 – 55; the card is for the particular subscriber's magazine and therefore a pre-personalized piece); rejecting selective pre-personalized books (Column 1, Lines 55 – 65); reprinting the pre-personalized signature of one of the rejected pre-personalized books (Column 1, lines 59 – 60; Anderson clearly states that upon rejection of the book the magazine is re-ordered and the a new card is punched and/or printed); and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized piece (Column 1, Lines 24 – 47 teaches of the different feeders on the binding line that are used to provide signatures; Column 1, Lines 55 – 65 clearly states upon rejection that the magazine is re-ordered which inherently means that the particular signatures will be fed from the feeders and also teaches of online printing of the pre-personalized card. Furthermore it also teaches of downstream delivery of the reordered magazine which means delivery down the binding line). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the feeders of Gruber with pre-personalized signatures as taught by Anderson in order to allow for mass or easier production of personalized printed products.

In regards to Claim 26, as applied to Claim 24, Gruber modified by Anderson further discloses wherein the step of printing personalized signatures is done offline with

respect to the binding line and placed into feeders (Column 1, Lines 24 – 47 discloses the signatures are placed particular feeders for a particular subscriber; Column 2, Lines 55 – 57 teaches that the signatures are placed into the feeders and from Figure 1 it is clear that the feeders are the beginning point of the binding line. Since the signatures are placed into the feeders [beginning of the binding line] it is inherent that all of the signatures are printed offline. This is further supported by the fact that the only printers in Anderson for online printing are for the inserted card [Column 3, Lines 15 – 24] and address label [Column 4, Lines 13 – 16]). If the feeders of Anderson become empty during production more signatures would need to be reprinted and that would be inherently done offline. Therefore the modification of Anderson inherently teaches wherein the step of reprinting the portion is done offline with respect to the binding line in certain situations.

Response to Arguments

Applicant's arguments, see Remarks, filed October 14, 2008, with respect to Claims 24 – 30, the arguments have been fully considered and are persuasive. The rejection of Claims 24 - 30 have been withdrawn.

Applicant's arguments filed on October 14, 2008 have been fully considered but they are not persuasive with respect to independent claims 1, 9, 15, 21, and 31.

In regards to the Argument of Claims 1 and 21 wherein the alternate medium interpretation is not a reasonable interpretation, the specification provides no definitions and only provides examples of alternate pieces. Since there is no definition in the specification the stance taken throughout prosecution is consistent with the specification

since the specification leaves the interpretation open to almost all possible interpretations.

In regards to the Arguments of Claim 9 that the art does not teach of "generating an alternate piece wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book", Applicant has not claimed any specific notification method. Just a general and very broad recitation of the notification and in light of such a broad limitation a generic book instead of a pre-personalized book is in itself a notification. A notification as claimed can be anything that is not the actual expected product, it does not have to be certain printed indicia. Page 6, Lines 11- 14 of Applicant's specification indicate examples of a notification but does not provide a clear definition of the notification. With respect to the fact that a recipient of Graushar's generic book can be aware of the intended book is not being used as an actual teaching of Applicant's method step but is used to explain a situation in which Applicant's method step is taught.

In regards to the Arguments of Claim 15 and the art not teaching "generating an alternate piece on the binding line" and "the alternate piece being of a different format from a rejected pre-personalized book", the alternate piece is generated on the binding line for at least the reasons that it is assembled on the binding line and that certain signatures, if so chosen, to be customized by being printed on the binding line. Furthermore, the alternate piece is a different format when an identical magazine is not made. In plain meaning, format is just a general makeup and therefore if the alternate piece is not identical, it is not the same makeup and therefore not the same format.

In regards to the Arguments of Claim 31 and the art not teaching a rejected book with a different medium and the Examiner allegedly using the broadest possible meaning rather than the broadest reasonable meaning, Applicant states that the examiner has no cause for such an interpretation even though the definition of "different medium" is not provided in the Claims. The Examiner was actually referring to the fact that it is not defined in the specification and therefore there is nothing for the examiner to be consistent with. This gives an extremely large range since a medium is merely a means of effecting or conveying something and with such a broad meaning different information is a different medium. Furthermore, the section in which the Examiner refers to in the office action from May 12, 2008 is a reference to alternate pieces, not alternate/different mediums. It is stated in that part of the Office Action that the different medium is not defined and therefore broadly interpreted since Applicant shows binding methods for books and then shows that alternate pieces can be books. Applicant provided no disclosure that alternate pieces are the same thing as an alternate/different medium. The capability to provide standard, customized and personalized information provides a means to providing replacements of generic and identical books and alternate pieces of a different medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
November 24, 2008

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725